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EXAMINER	
BORISSOV, IGOR N	

ART UNIT	PAPER NUMBER
3629	

DATE MAILED: 04/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/843,736	BANNAI ET AL.	
	Examiner	Art Unit	
	Igor Borissov	3629	MW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *03* MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *10 February 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *2-8,10-15 and 17-25* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *2-8,10-13 and 17-25* is/are rejected.

7)☒ Claim(s) *14-15* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claims 1, 9 and 16 have been canceled by the Applicant.

Claim Objections

Claim 8 is objected to because of the following informalities: examiner believes that the phrase "storing said energy consumption" means "storing said energy consumption data".

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2, 8, 10, 17 and 21 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 2, 8, 10 and 17. The term "the energy consumption" lacks antecedent basis.

Also, **claim 17**. The term "the energy service enterprise" lacks antecedent basis.

Claim 21, the term "or" renders the claim indefinite. Also, the term "the assured value" lacks antecedent basis.

Claim Rejections - 35 USC § 102

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 8, 10-12 and 17-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Yablonowski et al. (US 6,535,859).

Yablonowski et al. teach a method and system for maintaining lighting systems and for monitoring energy consumption of the lighting sytems, comprising:

Claim 8. Installing an energy-saving equipment with the installation cost thereof paid by the energy service enterprise (column 7, lines 4-10); measuring the energy consumption of said object equipment after installation of said energy-saving equipment; storing said energy consumption data before implementing energy-saving measures, together with attribute data of variable factors (column 6, lines 35-36); determining the difference of the resultant measured value from the energy consumption of said object equipment before installation of said energy-saving equipment previously stored in the database; calculating the amount of curtailment of the energy costs on the basis of the thus determined difference; and allowing said energy service enterprise to collect said installation cost from said amount of curtailment (column 3, lines 17-19, 49-61; column 4, line 66 – column 5, line 25).

Claim 10. Installing an energy-saving equipment with the installation cost thereof paid by the energy service enterprise (column 7, lines 4-10); measuring the energy consumption of said object equipment after installation of said energy-saving equipment; determining the difference of the resultant measured value from the energy consumption of said object equipment before installation of said energy-saving equipment previously stored in the database; calculating the amount of curtailment of the energy costs on the basis of the thus determined difference; and allowing said energy service enterprise to collect said installation cost from said amount of curtailment (column 3, lines 17-19, 49-61; column 4, line 66 – column 5, line 25).

Claim 12. See **claim 10.**

Claim 17. Preparing energy-saving measures (column 6, lines 5-9); assuring a quantity of curtailment of energy consumption available (column 6, lines 27-39); storing said energy consumption before taking energy-saving measures in said database, together with the attribute data of variable factors of the energy consumption; measuring

the energy consumption after taking said energy-saving measures, together with said attribute data; and comparing said measured value with the energy consumption before taking said energy-saving measures corresponding to said measured attribute data (column 6, lines 24-32, 54-56; column 8, lines 30-59).

Claim 19. See **claim 17.**

Claim 20. See **claim 17.**

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 2-7, 13 and 24-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yablonowski et al.

Claim 2. A database which stores past data about the energy consumption before taking energy-saving measures; measuring means which measures the energy consumption after taking energy-saving measures; and calculating means which calculates the energy curtailment quantities before and after taking energy-saving measures by incorporating measurement data measured by said measuring means via a communication line and comparing said measurement data and the past data stored in said database (column 3, lines 17-19, 49-61; column 4, line 66 – column 5, line 25). Information as to *in which form the database is stored* is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. *See: In re Gulack 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) In re Dembiczak 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999).*

Claim 3. See **claim 2.**

Claim 4. See **claim 2.**

Claims 5-6, said method and system, wherein said calculating means calculates the amount of curtailment of the energy costs on the basis of said energy curtailment quantity, and charges an amount obtained by multiplying said amount of curtailment by a predetermined ratio (column 8, lines 30-58).

Claim 7. Yablonowski et al. teach said method and system, wherein billing for a time period is callculated as a function of the power saving for that particular time period (column 8, lines 40-50). Information as to *if the total amount of the fixed and variable costs is Q, the annual amount of curtailment of energy costs is P, and α and β are positive coefficients (where $\alpha > \beta$), said energy service enterprise receives: X1% of the curtailment amount of energy costs when $P \geq \alpha Q$; X2% of the curtailment amount of energy costs when $\beta Q \leq P < \alpha Q$ (where, X1 <X2); and a predetermined amount when $P < \beta Q$* is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. *See: In re Gulack 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) In re Dembiczak 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999).*

Claims 13 and 21-23. Yablonowski et al. teach said method and system, wherein said energy service enterprise performs maintenance or improvement of the equipment subjected to energy-saving measures without compensation (column 8, lines 52-58), after reviewing the feasibility of the project and profit margin (column 6, lines 54-65).

However, Yablonowski et al. do not specifically teach that reviewing the feasibility of the project and profit margin includes establishing a predetermined reference value.

Official notice is taken that it is well known in the art that any cost estimate of a business project includes establishing predetermined reference values, such as calculating break even, cost of manufacturing, goods sold, etc.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Yablonowski et al. to include that reviewing the feasibility of the project and profit margin includes establishing a predetermined reference value,

because it would allow to accurately estimate funds needed for the project and avoid unexpected financial loss.

Claim 24. Yablonowski et al. teach said method and system, wherein said attribute data is data varying a characteristic of energy consumption (column 6, linefs 35-36).

Claims 11, 18 and 25. Yablonowski et al. teach said method and system, including installing an energy-saving equipment with the installation cost thereof paid by the energy service enterprise (column 7, lines 4-10); measuring the energy consumption of said object equipment after installation of said energy-saving equipment; storing said energy consumption data before implementing energy-saving measures, together with attribute data of variable factors (column 6, lines 35-36). Information as to *the content of said attribute data (temperature or humidity)* is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. *See: In re Gulack 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) In re Dembiczak 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999).*

Allowable Subject Matter

Claims 14 and 15 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 14 and 15. Yablonowski et al. teach said method and system, wherein billing for a time period is calculated as a function of the power saving for that particular time period (column 8, lines 40-50).

However, Yablonowski et al. do not specifically teach that if the total amount of the fixed and variable costs is Q, the annual amount of curtailment of energy costs is P, and α and β are positive coefficients (where $\alpha > \beta$), said energy service enterprise receives: X1% of the curtailment amount of energy costs when $P \geq \alpha Q$; X2% of the

curtailment amount of energy costs when $\beta Q \leq P < \alpha Q$ (where, X1 < X2); and a predetermined amount when $P < \beta Q$.

Response to Amendment

In response to applicant's argument that Yablonowski et al. do not teach energy-saving co-generator, examiner points out that "co-generator" features, upon which applicant relies in his arguments, is not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to applicant's argument that Yablonowski et al. do not teach calculating means for comparing the energy saving data before and after installing energy-saving equipment, the examiner maintains that Yablonowski et al. does, in fact, teach this feature (See: column 3, lines 17-19, 49-61 and discussion above).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication should be directed to Igor Borissov at telephone number (703) 305-4649.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 872-9306.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, John Weiss, can be reached at (703) 308- 2702.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington D.C. 20231

or faxed to:

(703) 872-9306 [Official communications; including After Final communications labeled "Box AF"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th floor receptionist.

JOHN G. WEISS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600